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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,877	06/11/2001	Ramesh B. Bambal	P32158	7701

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EXAMINER

SAUCIER, SANDRA E

ART UNIT PAPER NUMBER

1651

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/806,877**

Applicant(s)  
**Bambal et al.**

Examiner  
**Sandra Saucier**

Art Unit  
**1651**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 24, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above, claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 11, and 15 is/are allowed.
- 6) ☒ Claim(s) 12 and 16 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jun 11, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____                                    |

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#### DETAILED ACTION

Claims 10-20 are pending. Claims 10-16 are considered on the merits. Claims 17-20 are withdrawn from consideration as being drawn to a non-elected invention.

#### *Election/Restriction*

Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 9.

Applicant's election with traverse of Group I in Paper No. 9 is acknowledged. The traversal is on the ground that they are merely different embodiments of a single inventive concept. However, applicants have not delineated what they believe this single inventive concept is.

A national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the of following combinations of categories;

- (1) a product and a process specially adapted for the manufacture of said product; or
  - (2) a product and a process of use of said product; or
  - (3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
  - (4) a process and a apparatus specifically designed for carrying out said process; or
  - (5) a product, a process specially adapted for the manufacture of the said product and an apparatus specifically designed for carrying out said process.
- 37 CFR 1.475.

The groups of invention fall within category (3), a product and a method of use of that product and method making that product.

PCT Rule 13 does not provide for multiple compositions or multiple

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methods of use within a single application. Thus, the first appearing composition is combined with a corresponding first method of use and making of that product and the additional composition and method claims each constitute a separate group.

Arguments as to burden do not apply to national stage applications filed under USC 371.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***  
INDEFINITE

Claims 12 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 does not end with a period.

Claim 16 should depend from claim 15, not claim 13.

Claim 16 recites "and Hal is halogen, e.g. iodine or bromine;". It is unclear if the matter after e.g. is meant to further limit the claim. Please delete ", e.g. iodine or bromine" or insert it as a proper limitation.

***Allowable Subject Matter***

Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10, 11 and 15 are allowed.

US 5,216,176 and US 6,207,404 are cited as being of interest.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30 AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.

A handwritten signature in black ink, appearing to read 'Sandra Saucier', is positioned above the printed name and title.

Sandra Saucier  
Primary Examiner  
Art Unit 1651  
March 17, 2003